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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,782	01/17/2001	Glenn McGarry	018638-04-5010	7173

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MORGAN LEWIS & BOCKIUS LLP  
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WASHINGTON, DC 20004

EXAMINER
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BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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08/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/764,782

Applicant(s)

MCGARRY ET AL.

Examiner

Jason M. Borlinghaus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to:
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

To ensure clarity and clear understanding of examiner's rationale for application of cited prior art, terminology contained within parentheses indicates quoted language contained within said cited prior art reference while unquoted language contained within parentheses indicates the general concept as conveyed by said cited prior art reference. Such parenthetical terminology is to be interpreted as "reading on" or being "mapped to" the claim language prior to such parenthetical inclusions.

**Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over Litan (Litan, Robert E. & Santomero, Anthony M. *Brookings-Wharton Papers on Financial*

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*Services. The Brookings Institute. Washington, DC. 1998. pp. 115 – 116) in view of eSpeed (eSpeed Signs Deals with 7 Online Brokers to Give Consumers the Ability to Trade Bonds the Same Way They Trade Stocks. PR Newswire. May 15, 2000. p. 1)*

**Regarding Claim 1**, Litan discloses a (manual) trade capture system comprising:

- a first location having an interface for capturing executed trade data. (“Trade entry is the process of capturing trade data from where a transaction takes place (for example, the floor of an exchange)...” – see p. 116);
- a second location for accepting the captured trade data originating from the first location and performing middle and back office processing on the same. (“...and moving [captured trade data] to a central location where they are processed.” – see p. 116); and
- communicating (“moving”) the captured trade data between the first (“floor of an exchange”) and second (“central location”) locations.

Litan does not teach underlined claim limitations - a system comprising:

- a first computer having an interface for capturing executed trade data;
- a second computer for accepting the captured trade data originating from the first computer and performing middle and back office processing on the same; and
- a communication channel for communicating the captured trade data between the first and second computers.

Litan does not teach that the system is automated. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or

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automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Utilization of a computer(s) to automate data processing, such as middle and back office processing, and/or the use of a network to communicate data between multiple computers is old and well known in the art of information technology, as evidenced by eSpeed which discloses the computerization of a "brokers' middle and back office systems" and network connections between computers in such a system (see p. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Litan by incorporating computers and a network, as disclosed by eSpeed, allowing for utilization of conventional and standard technology and techniques to automate the system.

**Claims 2 – 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Litan and eSpeed as applied to Claim 1 above, and further in view of Downes (Downes, John. *Barron's Finance & Investment Handbook 2<sup>nd</sup> Edition*. Barron's Educational Services Inc. Hauppauge, New York. 1987. p. 311).

**Regarding Claim 2 – 4**, Litan discloses a system wherein:

- the first location is a client location (participant on "floor of an exchange"). (see p. 116).

Litan does not teach underlined limitations – a system wherein:

- the first computer is a client computer;
- the second computer is an investment bank computer.

- the communication channel is the Internet, and the interface is a browser.

While Litan does not explicitly state that the second location is an investment bank, Litan does state that processing does entail “[s]ettlement [which] involves moving funds within a clearinghouse or securities within a depository; moving funds between participant bank accounts to clearinghouse, depository, or brokerage accounts; or moving funds among participant bank accounts to pay for the transactions taken.” (see p. 116).

Utilization of an investment bank as an intermediary in securities transactions, such as between the issuer and the investing public, is old and well known in the art of financial management, as evidenced by Downes (see p. 311). It would have been obvious to one of ordinary skill in the art to have modified Litan and eSpeed by incorporating an investment bank as a second location, as investment banks are the conventional and standard participant in such transactions, and as settlement involves moving funds and/or securities which traditionally falls within the purview of investment bank duties (see Downes, p. 311).

Utilization of a computer(s) to automate data processing, the use of the Internet as a communication channel between such computers, and the interface being a browser is old and well known in the art of information technology, as evidenced by eSpeed (see p. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Litan, eSpeed and Downes by incorporating computers, the Internet and a browser, as disclosed by eSpeed, allowing

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for utilization of conventional and standard technology and techniques to automate the system.

**Regarding Claim 5**, Claim 5 recites similar limitations and/or would have been obvious based upon claims rejected above, Claims 1 – 4, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 4.

### ***Response to Arguments***

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

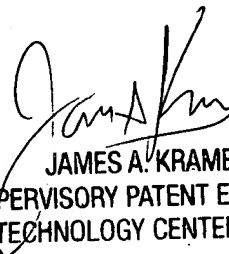
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMB

August 6, 2007

 8-6-07  
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